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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/597,280	07/19/2006	Fabio Vignoli	US040044US2	8784

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PHILIPS INTELLECTUAL PROPERTY & STANDARDS  
P.O. BOX 3001  
BRIARCLIFF MANOR, NY 10510

EXAMINER
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LIAO, JASON G

ART UNIT	PAPER NUMBER
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2169

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06/26/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/597,280	<b>Applicant(s)</b> VIGNOLI ET AL.	
	<b>Examiner</b> JASON LIAO	<b>Art Unit</b> 2169	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 June 2007 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/19/2006</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Priority***

1. Applicant's claim of priority to provisional application 60/537798 is acknowledged.

### ***Information Disclosure Statement***

2. IDS filed on 7/19/2006 is acknowledged.

### ***Drawings***

3. The drawings are objected to because they fail to show necessary textual labels of features or symbols in Fig. 1 as described in the specification. For example, placing a label, "media sources", with element 110 of Fig. 1, would give the viewer necessary detail to fully understand this element at a glance. A descriptive textual label for each numbered element in these figures would be needed to better understand these figures without substantial analysis of the detailed specification. Any structural detail that is of sufficient importance to be described should be labeled in the drawing. Optionally, the applicant may wish to include a table next to the present figure to fulfill this requirement. See 37 CFR 1.84(n)(o), recited below:

"(n) Symbols. Graphical drawing symbols may be used for conventional elements when appropriate. The elements for which such symbols and labeled representations are used must be adequately identified in the specification. Known devices should be illustrated by symbols which have a universally recognized conventional meaning and are generally accepted in the art. Other symbols which are not universally recognized may be used, subject to approval by the Office, if they are not likely to be confused with existing conventional symbols, and if they are readily identifiable.

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(o) Legends. Suitable descriptive legends may be used, or may be required by the Examiner, where necessary for understanding of the drawing, subject to approval by the Office. They should contain as few words as possible."

### ***Claim Objections***

4. Claim 2 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 2 merely recites a limitation that was identically recited in claim 1.

### ***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Current office policy does not consider software per se to be statutory subject matter. Software is not a method, rather, it is a set of instructions that, when executed, perform a method. Software is also not a system, it is a description of interrelated parts that comprise a system. Software lacks the mass required for a manufacture or composition of matter. Also see MPEP 2106.01

7. **Claims 1-11 rejected under 35 U.S.C. 101 because the claimed invention encompass to non-statutory subject matter.**

With respect to claims 1-4, 6-11, although these claims are directed to a system, all elements and limitations of the claims have pure software embodiments. Because no element and limitation is limited to a nonstatutory embodiment, the claims may encompass non-statutory subject matter.

**8. Claims 12-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

With respect to claims 12-20, the claims are directed to a method that have pure software embodiments. Current office policy is that a process, as recited by 35 USC 101, must 1) be tied to another statutory class or 2) transform underlying subject matter (such as an article or materials) to a different state or thing. No underlying statutory class and no transformation commensurate with *Gottschalk v. Benson* was found in these claims or the specification.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

**10. Claims 1-20 are rejected under 35 U.S.C. 102(a) as being anticipated by iTunes 4.0 hereinafter iTunes.**

With respect to claim 1, iTunes discloses

a system comprising:

A playlist generator ([www.apple.com/itunes/smartplaylists.html](http://www.apple.com/itunes/smartplaylists.html)) that includes

a selector that is configured to select

([www.apple.com/itunes/theater/playlists.html](http://www.apple.com/itunes/theater/playlists.html), GUI interface including mouse):

a plurality of items from a collection of items of a user  
([www.apple.com/itunes/smartplaylists.html](http://www.apple.com/itunes/smartplaylists.html), “And with iTunes 4, you simply indicate your  
desired criteria — like all the rock songs you’ve added to your library in the past month.”)

one or more new-items from one or more other sources of items  
([/www.apple.com/music/store/](http://www.apple.com/music/store/))

and a mixer that is configured to generate a playlist from the plurality of items

([www.apple.com/itunes/smartplaylists.html](http://www.apple.com/itunes/smartplaylists.html), “The power to create playlists  
by mixing music tracks from different albums and genres has always been  
one of the cool features of iTunes.”) and one or more new-items  
([/www.apple.com/music/store/](http://www.apple.com/music/store/) top picture, “Download songs directly to  
your music library”),

wherein the selector is configured to select the plurality of items  
([www.apple.com/itunes/theater/playlists.html](http://www.apple.com/itunes/theater/playlists.html), mouse pointer) and one or more new-items  
([www.apple.com/music/store/browse.html](http://www.apple.com/music/store/browse.html), “The iTunes Music Store is so user-friendly and so  
easy to navigate that you can drill down several layers deep with just a few mouse clicks, and  
search the store’s entire music inventory in seconds.”) based on preferences of the user  
([www.apple.com/itunes/smartplaylists.html](http://www.apple.com/itunes/smartplaylists.html), Constructs based on date range, ratings, etc.), and  
the collection of items of the user does not include the one or more new-items  
([www.apple.com/music/store/browse.html](http://www.apple.com/music/store/browse.html),  
“<http://web.archive.org/web/20031002021025/www.apple.com/music/store/browse.html>”).

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With respect to claim 12, iTunes discloses the elements and limitations of claim 1, and further discloses a method ([www.apple.com/itunes/theater/playlists.html](http://www.apple.com/itunes/theater/playlists.html) shows actions being performed)

With respect to claim 2, iTunes discloses the collection of items of the user ([www.apple.com/itunes/smartplaylists.html](http://www.apple.com/itunes/smartplaylists.html), “And with iTunes 4, you simply indicate your desired criteria — like all the rock songs you’ve added to your library in the past month.”).

With respect to claims 3 and 13, iTunes discloses rendering the playlists ([www.apple.com/itunes/theater/playlists.html](http://www.apple.com/itunes/theater/playlists.html), playlist is displayed at end)

With respect to claims 4 and 14, iTunes discloses including a purchase module ([www.apple.com/music/store/shop.html](http://www.apple.com/music/store/shop.html)) that is configured to facilitate a selective purchase ([www.apple.com/music/store/shop.html](http://www.apple.com/music/store/shop.html) “When you’re ready to buy a song, it gets even easier. The iTunes Music Store is designed for instant gratification, letting you buy a song with just one click.”) of each of the one or more new-items ([www.apple.com/music/store/shop.html](http://www.apple.com/music/store/shop.html) “Unlike the case with CDs, where you have to pay for the whole album to get the two or three songs you really want, the iTunes Music Store lets you buy only the songs you really like and want to own.”).

With respect to claims 5 and 15, iTunes discloses the selector includes a memory (iTunes can run on the Macintosh. Macintoshes are Personal Computers that include memory) that is configured

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to store identifications of previously selected new-items, and the one or more new-items exclude the previously selected new-items, based on the identifications

([www.apple.com/music/store/shop.html](http://www.apple.com/music/store/shop.html), Source pane has storage source labeled “Sarah Brightman” [www.apple.com/itunes/theater/playlists.html](http://www.apple.com/itunes/theater/playlists.html), generation can be based on artists. It is implicit that generation of a new source by other well known artists would exclude Sarah Brightman.).

With respect to claims 6 and 16, iTunes discloses a recommender module that is configured to create of subset of source items from the one or more other sources of items, based on one or more general preferences of the user ([www.apple.com/itunes/theater/playlists.html](http://www.apple.com/itunes/theater/playlists.html), selection of preferences narrows possible songs in generated playlist), wherein the selector selects the one or more new-items from the subset of source items ([www.apple.com/itunes/theater/browse.html](http://www.apple.com/itunes/theater/browse.html), selector can select items from a subset based on preferences).

With respect to claim 7, iTunes discloses the one or more other sources of items are accessible via an Internet access ([www.apple.com/music/store/shop.html](http://www.apple.com/music/store/shop.html), iTunes shop is accessible over the internet)

With respect to claim 8, iTunes discloses determining a preferred proportion of new-items relative to the plurality of items ([www.apple.com/itunes/theater/playlists.html](http://www.apple.com/itunes/theater/playlists.html), user has an option for “Live updating”)



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With respect to claims 9 and 18, iTunes discloses the selector is further configured to select the one or more new-items based on a popularity of each new-item of the one or more new-items ([www.apple.com/itunes/theater/playlists.html](http://www.apple.com/itunes/theater/playlists.html), User has the option to select parameters based on ranking such as number of stars).

With respect to claims 10 and 19, iTunes discloses the system is further configured to facilitate selectively adding each new-item of the one or more new-items to the collection of items ([www.apple.com/itunes/theater/browse.html](http://www.apple.com/itunes/theater/browse.html)).

With respect to claims 11 and 20, iTunes discloses memory that is configured to store ancillary information associated with each new-item that is selectively added to the collection of items ([www.apple.com/itunes/theater/browse.html](http://www.apple.com/itunes/theater/browse.html), new songs have information such as rating, author, etc.), to facilitate subsequent selections ([www.apple.com/itunes/theater/playlists.html](http://www.apple.com/itunes/theater/playlists.html), information is used as selection criteria).

With respect to claim 17, iTunes discloses the elements and limitations of claim 8, and further discloses combining the plurality of items and the one or more new-items to provide the playlist is based on the preferred proportion ([www.apple.com/itunes/theater/playlists.html](http://www.apple.com/itunes/theater/playlists.html), user has an option for “Live updating”).

***Remarks***

Due to the limitations of paper-based media, copies of referenced Quicktime movies (referred above as apple.com/itunes/theater/\*) have not been included with the copies of NPL.

***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

<http://forums.ilounge.com/archive/index.php/t-14319.html>, Ashawley et al.

Clarification of rejection for claims 8, 17:

“To have iTunes continually modify your Smart Playlist as songs are added to or removed from your library, make sure "Live updating" is selected.

So, what whis means is as you add tunes to the iTunes library the tunes will be added to the smartlist if they meet the criteria.

Seems pretty basic to me, but I think folks have been assuming this means the list will be updated dynamically on the iPod if you check this. Not true. That will happen regardless.”

US 6,954,763 Numome et al.

Playlist-oriented music downloads over the internet

US 6,993,532 Platt et al.

Dynamic playlist generation on basis of metadata/preferences

US 7,136,874 B2 Mercer et al.

Menu structure for media files (rendering)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON LIAO whose telephone number is (571)270-3775. The examiner can normally be reached on M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pierre Vital can be reached on 571-272-4215. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jason Liao/  
Examiner, Art Unit 2169  
6/20/08

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